

## **REMARKS**

### **I. General**

Claims 1-101 were pending in the application, and all of such claims were rejected in the Office Action mailed July 8, 2005. The issues raised in the present Office Action are:

- Claims 1-2, 6-26, 28-34, 36-44, 46-76, and 78-87 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,618,734 issued to Williams et al. (hereinafter "*Williams*");
- Claims 93-101 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,701,313 issued to Smith (hereinafter "*Smith*");
- Claims 3-5, 35, and 88-92 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Williams* in view of *Smith*; and
- Claims 27, 45, and 77 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Williams*.

In response, Applicant respectfully traverses the outstanding claim rejections, and requests reconsideration and withdrawal thereof in light of the amendments and remarks presented herein.

### **II. Amendments**

Claims 93-101 are canceled without prejudice herein. These claims are canceled for the sole purpose of expediting prosecution, and is not a concession by Applicant that the rejection of these claims is proper. As explained further below, the remaining claims 1-92 are clearly allowable over the rejections of record, and thus the cancellation of claims 93-101 reduces the issues present in this application and renders it in condition for allowance.

### **III. 35 U.S.C. § 102 Rejections Over *Smith***

Claims 93-101 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Smith*. As discussed above, claims 93-101 are canceled without prejudice. Therefore, this rejection is moot.

#### **IV. Rejections Over *Williams***

Claims 1-2, 6-26, 28-34, 36-44, 46-76, and 78-87 are rejected under 35 U.S.C. § 102(e) as being anticipated by *Williams*. Claims 3-5, 35, and 88-92 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Williams* in view of *Smith*, and claims 27, 45, and 77 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Williams*. Thus, each of the rejections of claims 1-92 is based at least in part on *Williams*.

However, Applicant respectfully asserts that *Williams* is not prior art to the present invention, as Applicant has previously submitted a declaration that the inventors of the present application conceived of the claimed invention prior to July 20, 2000, the filing date of *Williams*, see Applicant's Response to Non-Final Office Action submitted April 6, 2005 and accompanying Declaration of Alan Cayton under 37 C.F.R. § 1.131. Accordingly, without conceding that *Williams* teaches or suggests the claim elements as asserted by the present Office Action, the rejections must fall as Applicant has antedated *Williams*.

##### **A. Record of Examiner Interview**

Applicant's attorney thanks the Examiner for his time and consideration in the telephone interview conducted October 28, 2005. Applicant respectfully submits the following record of this interview under M.P.E.P. § 713.04:

The following persons participated in the interview: Examiner Jonathan Oellette and Applicant's attorney, Jody Bishop. During the interview, Applicant's attorney proposed canceling claims 93-101 and noted that all of the remaining claims stand rejected over *Williams*, which the previously submitted Declaration of Alan Cayton antedates under 37 C.F.R. § 1.131. The Examiner raised concern as to the sufficiency of the evidence and the diligence established by the previously submitted Declaration. No agreement was reached in the interview, and Applicant's attorney agreed to submit this written response for the Examiner's further consideration.

**B. Declaration Under 37 C.F.R. § 1.131**

In the above-summarized Examiner interview, the Examiner raised concern as to the effectiveness of the Declaration of Alan Cayton submitted April 6, 2005 ("Cayton Declaration") for antedating the July 20, 2000 date of *Williams*. First, the Examiner raised concern as to whether the evidence submitted was insufficient to establish a conception of the invention prior to July 20, 2000. Further, the Examiner also raised concern as to the establishment of diligence during the period for which diligence is required. Applicant addresses each of these points below, and respectfully submits that the Cayton Declaration is effective for antedating *Williams*.

**i. Sufficiency of Evidence of Conception of Invention**

First, Applicant respectfully submits that the evidence submitted with the Cayton Declaration is sufficient to support the assertion that the claimed invention was conceived prior to July 20, 2000. As set forth in M.P.E.P. § 715.07, conception is the mental part of the inventive act, but it must be capable of proof, as by drawings. *Mergenthaler v. Scudder*, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897) established that conception is more than a mere vague idea of how to solve a problem; the means themselves and their interaction must be comprehended also. Applicant respectfully submits that the evidence submitted in the Cayton Declaration is sufficient to establish conception by the inventors prior to July 20, 2000, as discussed further below.

Exhibit A to the Cayton Declaration includes FIGURES, which correspond to FIGURE 1 of the present application. The Cayton Declaration sets forth that Alan Cayton comprehended an embodiment of this invention, as described more fully in conjunction with FIGURE 1 of the present application, prior to June 12, 2000. The Examiner is respectfully reminded that evidence of actual reduction to practice is not required. Rather, Applicant's evidence (i.e., possession of FIGURE 1 of the present application) is sufficient to give rise to an inference that the invention was conceived prior to June 12, 2000, and thus prior to July 20, 2000, particularly considering that the inventor declares that he had conceived of the details set forth for this FIGURE in the present application prior to June 12, 2000. Further, considering that the application was filed less than one month after July 20, 2000 (i.e., on

August 17, 2000), the fact that FIGURE 1 existed prior to July 20, 2000 supports the assertion that the inventors had, prior to July 20, 2000, conceived of the details discussed with FIGURE 1 in the present application.

Further, the FIGURES included in the evidence are not a “mere vague idea” of how to solve a problem, but instead identify the elements and illustrates interaction between the elements. More specifically, the FIGURES included in the evidence show an application generator with an associated user interface coupled therewith. The FIGURES further show IVR and Browser (web-based) applications that are illustrated as generated by the application generator. The IVR and Browser applications are labeled as “SAQs”, and the evidence further includes pages explaining that SAQ (Self-Administered Qualification, *see* page 1 of Exhibit A) is: “A Software Product That Provides a Powerful, Customized Operating Environment for Applicant Screening, Qualification and Scheduling” (*see* page 3 of Exhibit A). Thus, the IVR and Browser applications generated by the application generator are described as software applications for qualifying candidates. Further, the FIGURE on page 2 of Exhibit A shows a common symbol used for representing a telephone coupled to the IVR application, thus illustrating that a candidate can interact with the IVR application via a telephone. The FIGURE further shows the Browser application as coupled to the World Wide Web (WWW) communication network, and a representation of a computer (e.g., PC) coupled to the WWW network, thus illustrating that a candidate can interact with the Browser application via a computer coupled to the WWW network. Accordingly, this evidence shows that the inventor possessed more than a mere vague idea because it shows the various elements and their interactions.

Further, to dispose of a reference, Applicant need only establish prior conception of as much of the claimed invention as the reference happens to show. For instance, in *In re Stempel*, 241 F.2d 755, 113 USPQ 77 (CCPA 1957), the CCPA concluded:

We are convinced that under the law all the applicant can be required to show is priority with respect to so much of the claimed invention as the references [sic] happens to show. When he has done that he has disposed of the references....

In the case of a reference, it is fundamental that it is valid only for what it discloses and if the applicant establishes priority with respect to that disclosure, and there is no statutory bar, it is of no effect at all....

The rule [1.131] must be construed in accordance with the rights given to inventors by statute and this excludes a construction permitting the further use of a reference as a ground of rejection after all pertinent subject matter in it has been antedated to Dean satisfaction of the patent office.

In the present case, Applicant's evidence certainly shows at least as much detail as is provided in *Williams*. Indeed, Applicant's evidence more clearly sets forth that an application generator generates the applications (e.g., IVR SAQs and Browser SAQs) than does the teaching of *Williams*. *Williams* does not clearly establish that an application generator generates the application to interact with candidates. Indeed, Applicant finds no express teaching in *Williams* that an application generates the application to interact with candidates. For instance, while *Williams* mentions "the present system and method accepts changes to a client's or employer's employment criteria and implements those changes overnight" (col. 2, lines 38-41 of *Williams*), *Williams* makes no mentions of how an application is created to interact with candidates to test for such employment criteria (e.g., a code developer could work to manually create the application with which candidates interact, rather than an application generator generating such application).

To the extent that any inference regarding an application generator can be drawn from the teaching of *Williams*, the evidence submitted in the Cayton Declaration clearly establishes priority with respect to so much of the claimed invention as *Williams* teaches. That is, the evidence provides at least as much detail concerning an application generator generating applications with which candidates can interact as does the applied *Williams* reference.

In view of the above, Applicant respectfully submits that the Cayton Declaration and its corresponding evidence is sufficient to establish conception prior to July 20, 2000.

## ii. Diligence

Applicant also respectfully submits that the Cayton Declaration provides sufficient information regarding the activity during the period for which diligence is required to establish such diligence on the part of Applicant. To antedate *Williams*, diligence must be

shown from prior to July 20, 2000 until the filing date of the present application, August 17, 2000. As the Cayton Declaration sets forth, Applicant diligently worked toward engaging patent counsel for preparing and filing the present application, discussing the invention with patent counsel, reviewing drafts of the patent application provided by patent counsel, providing timely feedback on the drafts of the patent application to patent counsel, and timely approving the final draft of the patent application and executing the declaration for such patent application and returning such executed declaration to patent counsel for filing of the patent application, which patent counsel timely filed with the USPTO after receiving the executed declaration.

For instance, the Cayton Declaration provides that Strategic Outsourcing corporation engaged Fulbright & Jaworski L.L.P. as patent counsel for the preparation of the patent application, and wrote a retainer check to Fulbright & Jaworski L.L.P. on June 22, 2000, prior to the July 20, 2000 date of *Williams*, see item 7 of the Cayton Declaration. Fulbright then prepared a draft of the application and sent such draft to the inventors July 28, 2000. Providing a first draft of a patent application in approximately one month after being engaged to do so is very diligent and expeditious on the part of Applicant's patent counsel. During this time, the inventors were awaiting such a draft to be provided to them from their patent counsel. No further acts could be reasonably expected during this period by the inventors to more diligently seek patent protection. The inventors were unfamiliar with the patent process, and thus reasonably relied on engaged patent counsel that is registered to practice before the USPTO to prepare the patent application.

Upon receiving the draft of the application, the inventors diligently reviewed the draft and provided comments to patent counsel. Patent counsel incorporated the inventors' comments and provided a final draft of the patent application on August 15, 2000. Thus, within 18 days after the draft of the application was sent to the inventors, it had been reviewed by the inventors and Applicant's patent counsel had revised the draft into final form in accordance with the feedback received from the inventors. The inventors executed the formal documents for the final draft of the application on August 16, 2000, and Applicant's patent counsel filed the patent application on August 17, 2000.

The above actions illustrate that Applicant diligently pursued preparation and filing of the present patent application from prior to July 20, 2000 until its filing less than one month later on August 17, 2000. Therefore, Applicant respectfully submits that the above activity is sufficient to establish diligence on the part of Applicant during the period for which such diligence is required.

In view of the above, the Cayton Declaration is sufficient to antedate *Williams*, and therefore the rejection of claims 1-92 should be withdrawn.

**C. *Williams* Fails to Teach All Elements of Independent Claims 1, 30, 54 and 62**

The present Office Action asserts that claims 1-2, 6-26, 28-34, 36-44, 46-76, and 78-87 are anticipated under 35 U.S.C. § 102(e) over *Williams*. To anticipate a claim under 35 U.S.C. § 102, a single reference must teach every element of the claim, *see* M.P.E.P. § 2131. *Williams* fails to teach every element of claims 1-2, 6-26, 28-34, 36-44, 46-76, and 78-87, as discussed below.

Independent claim 1 recites, in part, “executing a computer program, said computer program receiving as input from said employer a desired hiring criteria of said employer; based on said desired hiring criteria of said employer, said computer program generating at least one customized application program that is executable to interact with candidates for employment with said employer and determine whether each of said candidates is qualified for employment with said employer” (emphasis added).

Independent claim 30 recites, in part, “a computer program executable by said processor-based device to receive as input desired hiring criteria of said employer and generate at least one application program” (emphasis added).

Independent claim 54 recites, in part, “code for generating at least one qualification program for interacting with candidates in accordance with said received preferences and determining whether each of said candidates qualifies for a position of employment with said employer” (emphasis added).

Independent claim 62 recites, in part, “allowing an employer access to a computer executable program, wherein said computer executable program enables said employer to generate at least one customized application program based on a desired hiring criteria of said employer, said desired hiring criteria defining at least one attribute desired to be possessed by a candidate to be considered qualified for a position of employment” (emphasis added).

*Williams* fails to teach at least the above elements of claims 1, 30, 54, and 62. For instance, *Williams* does not teach a computer program “generating at least one customized application program that is executable to interact with candidates”, as recited by claim 1. While *Williams* mentions receiving employer’s hiring criteria and using an application program to interact with candidates to screen the candidates against the employer’s hiring criteria, *Williams* provides no express teaching that the application program with which the candidates interact is generated by another computer program. Rather, in *Williams*, such application program could be generated through manual coding by a developer.

Accordingly, *Williams* fails to teach all elements of independent claims 1, 30, 54, and 62, and thus fails to anticipate these claims under 35 U.S.C. § 102.

#### **D. Dependent Claims**

Each of dependent claims 2-29, 31-53, 55-61, and 63-92 depend either directly or indirectly from one of independent claims 1, 30, 54 and 62, and thus inherit all limitations of the respective independent claims from which they depend. It is respectfully submitted that dependent claims 2-29, 31-53, 55-61, and 63-92 are allowable not only because of their dependency from their respective independent claims for the reasons discussed above, but also in view of their novel claim features (which both narrow the scope of the particular claims and compel a broader interpretation of the respective base claim from which they depend).



## **V. Conclusion**

In view of the above, Applicant believes the pending application is in condition for allowance.

The required fee for this response is enclosed. If any additional fee is due, please charge Deposit Account No. 06-2380, under Order No. 59428/P001US/10020580 from which the undersigned is authorized to draw.

Dated: November 1, 2005

Respectfully submitted,

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